

## **Remarks**

### **1. Summary of the Office Action**

In the office action mailed August 17, 2010, the Examiner rejected claims 1, 2, 4, 5, 13-15, and 20-24 under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent Application Pub. No. 2003/0128229 (Colson) in view of U.S. Patent Application Pub. No. 2003/0187806 (Banerjee). Further, the Examiner rejected claims 3 and 6 under 35 U.S.C. § 103(a) as being allegedly obvious over Colson in view of Banerjee in view of U.S. Patent Application Pub. No. 2003/0083041 (Kumar), the Examiner rejected claims 16-19 under 35 U.S.C. § 103(a) as being allegedly obvious over Banerjee in view of Colson, and the Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being allegedly obvious over Colson in view of Banerjee in view of U.S. Patent Application Pub. No. 2003/01777248 (Brown).

### **2. Status of the Claims**

Applicant has cancelled claims 1-3 and 20-25 without prejudice, and in the spirit of cooperation. Now pending are claims 4-6 and 13-19, of which claims 4, 13, and 16 are independent and the remainder are dependent.

### **3. Response to the Rejections**

With all due respect, Applicant notes that the Examiner has again clearly erred in rejecting the claims, and that the rejections should therefore be withdrawn and the claims should be allowed. Further, Applicant respectfully submits that it is now time to allow this case, considering the extensive prosecution history.

In this instance, the Examiner rejected each of independent claims 4, 13, and 16 on grounds of alleged obviousness over Colson and Banerjee. Yet those references, whether

considered alone or in combination, clearly fail to disclose, suggest, or reasonably lead to the recited invention, and thus one of ordinary skill in the art at the time of Applicant's invention, having no advanced knowledge of Applicant's invention, would not have been led by Colson and Banerjee to Applicant's invention. The Examiner therefore clearly did not *prima facie* obviousness of the claims over Colson and Banerjee, and so the claims should be allowed.

**a. Claims 4-6 and 13-15**

At a minimum, Colson and Banerjee fail to suggest the claimed invention including the feature of *during transmission of the web content within the communication path from a content server to a client station, computing a size-based cost to access the web content*, as recited in various ways by independent claims 4 and 13. Thus, it follows naturally that, when rejecting claims 4 and 13, the Examiner did not actually point to any such teaching in the cited art or, for that matter, even allege that the cited art would suggest the invention including this feature.

Considering claim 4, for instance, the Examiner alleged that Colson teaches, during transmission of web content within the communication path from the content server to the client station, engaging in interstitial communication with the client station to receive user approval to pay the cost and, after receiving the user approval, sending the web content along to the client station. But Colson does not teach this.

Indeed, Applicant has not found in Colson any teaching of carrying out these functions *during transmission of web content within the communication path from the content server to the client station*. At best Colson teaches that, *after the user has approved or selected the content cost*, the content would *then* be retrieved and transcoded, and that the transcoding would occur at the intermediary *unless the content server has the ability to do the transcoding*. (See paragraph

0023 of Colson.) The fact that the content server, if it had the ability to do the transcoding, would do the transcoding, makes clear the fact that the web content was not yet being transmitted in the communication path from the content server to the client station at the time of any interstitial communication with the client station regarding cost.

Furthermore, after then admitting that Colson fails to disclose computing a size-based cost to access the web content, the Examiner turned to rely on Banerjee for a disclosure of computing and displaying a sized based cost of web content. But the Examiner did not allege or seek to establish that the art taught during transmission of the web content within the communication path from the content server to the client station, computing a size-based cost to access the web content. At best, all the Examiner did regarding this feature was point out a disclosure of computing size-based cost. But Applicant is not seeking protection for computing sized based cost for web content in the abstract, and Applicant's claims therefore do not recite such a limited concept. Rather, claim 4 intentionally recites the innovation including *during transmission of the web content within the communication path from the content server to the client station*, computing the size-based cost to access the web content.

The Examiner's analysis did not satisfy the requirement of M.P.E.P § 2142, which provides that, to establish *prima facie* obviousness, an Examiner must clearly articulate reasoning with rational underpinnings to support the legal conclusion of obviousness. Merely asserting (incorrectly, Applicant submits) that Colson teaches the interstitial communication features noted above occurring during transmission of web content from the content server to the client station and then pointing out that Banerjee teaches the concept of computing size-based cost of web content clearly does not amount to an allegation or articulation of reasoning that the

invention, including computing the size-based cost *during transmission of the web content within the communication path from the content server to the client station*, would in any way follow from the limited teachings of Colson and Banerjee.

Even if the Examiner's allegation about what Colson teaches had been correct, the Examiner still did not allege or establish that the invention of claim 4 would have been obvious to a person of ordinary skill who had no advanced knowledge of Applicant's invention. This is so, at a minimum, because the Examiner did not address the invention including the claim feature of *computing the size-based cost during transmission of the web content within the communication path from the content server to the client station*, and further because that feature would not have followed reasonably from the limited teachings of Colson and Banerjee.

Because the Examiner did not establish *prima facie* obviousness of claim 4, Applicant submits that claim 4 should be allowed. Further, Applicant submits that claims 5-6 should be allowed for at least the reason that they depend from allowable claim 4.

The Examiner erred in largely the same way when rejecting independent claim 13, which likewise recites *during transmission of the web content within the communication path from the content server to the client station, determining a size-based cost to access the web content*.

Moreover, in addition to clearly erring in that manner, the Examiner *additionally* erred in rejecting claim 13, because the Examiner did not even allege that Colson or Banerjee or the combination of Colson and Banerjee teaches or in any way suggests the recited invention including the claim feature of *during transmission of the web content within the communication path from the content server to the client station, adding into the web content an indication of cost of the web content*. Notably, the Examiner merely alleged that Colson teaches adding an

indication of size-based cost into the web content, but the Examiner did not allege that that occurs during transmission of the web content within the communication path from the content server to the client station. This omission by the Examiner makes sense, since Colson does not include such a teaching.

For these reasons, the Examiner also clearly did not establish *prima facie* obviousness of claim 13, and therefore Applicant submits that claim 13 is allowable. Further, Applicant submits that claims 14-15 are allowable as well for at least the reason that they each depend from allowable claim 13.

**b. Claims 16-19**

Applicant submits that the Examiner also clearly erred in rejecting claim 16. In this case, the Examiner sought to combine and modify the teachings of the reference in a manner that makes little sense given the teachings of the references, such that the Examiner's proposed modification would clearly not have logically followed to one of ordinary skill in the art.

In rejecting claim 16, the Examiner first relied on Banerjee for a teaching of receiving web content, computing a size-based cost of content referenced by a link in the received web content, adding an indication of that cost to the received web content, and presenting the resulting web content. It seems that the Examiner characterized Banerjee in this manner in an effort to make it seem as though the teachings of Banerjee were so general. But in fact, the teachings of Banerjee are not so general and would therefore not have been read in such a general manner by a person of ordinary skill in the art who lacked the advance knowledge of Applicant's invention that the Examiner now possesses.

Banerjee is specifically focused on a client browser itself receiving web content, determining the size-based cost of referenced content, and adding the indication of the size-based cost to the content so that when the browser itself presents the content, the browser will present the size-based cost when the browser presents the web content. Banerjee does not generally teach just any entity carrying out these functions but is particularly focused on the client browser doing so.

The Examiner next stated that Banerjee does not teach sending the web content, including the indication (of size-based content), along the communication path to the client station. The Examiner is correct. Banerjee fails to teach that functionality because Banerjee discloses as a basic matter that *the client station itself is the device that does the determining and adding of size-based cost*, so that it would make no sense in the context of Banerjee to perform that function and to then send the web content including that cost indication *to the client station*.

Indeed, modifying Banerjee to have the size-based cost be included in the web page that is sent to the client station would be directly contrary to and inconsistent with the core purpose and principle of operation of Banerjee and would result in a redundant and therefore inefficient and non-obvious arrangement. In particular, the result of making such a modification would be that the client station would receive the web content already containing the indication of size-based cost and the client station would then itself determine and add to the web content the indication of size-based cost. Those of ordinary skill in the art would not have been sensibly motivated to achieve such a redundant and inefficient process, even in hindsight. Further M.P.E.P. §§ 2143.01(V) and 2143.01(VI) precludes a finding of *prima facie* obviousness in this situation.

In rejecting claim 16, after overbroadly characterizing Banerjee as noted above, the Examiner stated that it would have been obvious to incorporate Colson's teaching of a portal sending web content, including the indication, along the communication path to the client station. But for the foregoing reasons, Applicant submits that the Examiner's statement was clearly erroneous. Furthermore, Applicant does not acquiesce in the Examiner's suggestion that Colson teaches sending the web content including "the indication" (as recited and defined by claim 16) along the communication path to the client station.

For at least these reasons, Applicant submits that the Examiner clearly did not establish *prima facie* obviousness of claim 16, and therefore Applicant submits that claim 16 is allowable. Further, Applicant submits that claims 17-19 are allowable as well for at least the reason that they each depend from allowable claim 16.

#### **4. Conclusion**

For the foregoing reasons, and without acquiescing in any assertion by the Examiner that is not expressly addressed by these remarks, Applicant submits that all of the pending claims are in condition for allowance, and Applicant thus respectfully requests favorable reconsideration.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is welcome to call the undersigned at (312) 913-2141.

Respectfully submitted,

**MCDONNELL BOEHNEN  
HULBERT & BERGHOFF LLP**

Date: November 17, 2010

By: /Lawrence H. Aaronson/  
Lawrence H. Aaronson  
Reg. No. 35,818